

REMARKS

At the outset, the Examiner is thanked for the thorough review and consideration of the pending application. The Office Action dated June 24, 2009 has been received and its contents carefully reviewed. Claims 1-17 are currently pending. Reexamination and reconsideration of the pending claims are respectfully requested.

The Office Action rejects claims 1-13 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,011,078 to Reich et al. (*Reich*) in view of U.S. Patent No. 4,260,696 to Blount (*Blount*). Applicants respectfully traverse the rejection.

To establish *prima facie* obviousness of a claimed invention, all the elements of the claim must be taught or suggested by the prior art. The combined teaching of *Reich* and *Blount* fails to teach or suggest all the elements of claims 1-13, and thus cannot render these claims obvious.

Claim 1 recites, “5-90 parts by weight of a polyurethane containing a Brønsted salt.” The present invention further explains that “[t]he Brønsted salt provides the photochromic dye contained in the primer layer formed by the primer composition with polar environment.” *Specification*, page 4, lines 18-20. *Reich* fails to teach or suggest at least this element of claim 1. In fact, the Office Action admits that “Reich ... does not teach the polyurethane comprising a Brønsted acid.” *Office Action*, page 2. *Blount* does not cure the deficiency of *Reich*. The Office Action cites *Blount* for disclosing that “[t]he suphonated isocyanate-terminated polyurethane prepolymer may be completely or partly neutralized at the onset by the addition of amines, metal alcoholates, metal oxides, metal hydroxide or metal carbonates.” *Blount*, column 8, lines 12-16. Here, *Blount* only discloses adding a basic compound (e.g., amines) to neutralize the polyurethane prepolymer, and does not disclose that the prepolymer contains a Brønsted salt. In addition, *Blount* is silent with respect to the amount of basic compounds added to the polyurethane prepolymer, while claim 1 recites, “5-90 parts by weight of a polyurethane.”

Furthermore, *Blount* “relates to a process for the production of polyurethane silicate foams and resinous products utilizing aldehyde-broken down alkali metal cellulose silicate polymer.” *Blount*, column 1, lines 15-18. *Reich* “relates to aqueous, radiation-curable coating

composition which comprise at least one water-dispersible polymer or an aqueous polymer dispersion based on such a polymer, and at least one further water-soluble or water-dilutable, radiation-curable compound which is different from the polymer.” *Reich*, column 1, lines 4-8. *Reich* and *Blount* are in two different technical fields. There is no teaching or suggestion in either *Reich* or *Blount* that the process for the production of polyurethane silicate foams and resinous products could be used in preparing aqueous, radiation-curable coating composition. Thus, the Office Action fails to provide a rationale to support a conclusion that “a person of ordinary skill in the art would have been motivated to combine [*Reich* and *Blount*] to achieve the claimed invention and that there would have been a reasonable expectation of success.” *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006). Because of this shortcoming, the rationale presented in the Office Action cannot be used to support a conclusion that pending claims would have been obvious to one of ordinary skill in the art.

Accordingly, claim 1 is allowable over the combined teaching of *Reich* and *Blount*. Claims 2-13 variously depend from claim 1, and are also allowable for at least the same reasons as claim 1.

The Office Action rejects claims 14-17 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,889,413 to Ormsby et al. (*Ormsby*) in view of *Reich* and *Blount*. Applicants respectfully traverse the rejection.

Claims 14-17 variously depend from claim 1, and incorporate all the elements of claim 1. As discussed, the combined teaching of *Reich* and *Blount* fails to teach or suggest at least the above-recited element of claim 1, namely, “5-90 parts by weight of a polyurethane containing a Brønsted salt.” *Ormsby* does not cure the deficiency of *Reich* and *Blount*. The Office Action only cites *Ormsby* for disclosing a photochromic article. Office Action, page 3. *Ormsby* is also silent with respect to the above-recited element of claim 1. Accordingly, claim 1 and its dependent claims 14-17 are allowable over the combined teaching of *Reich*, *Blount*, and *Ormsby*.

Applicants believe the application is in condition for allowance and early, favorable action is respectfully solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at (202) 496-7500 to discuss the steps necessary for placing the application in condition for allowance. All correspondence should continue to be sent to the below-listed address.

If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time, or any other fees required to complete the filing of this response, may be charged to Deposit Account No. 50-0911. Please credit any overpayment to deposit Account No. 50-0911.

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Respectfully submitted,

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